

REMARKS/ARGUMENTS

Applicant would like to thank the Examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and it is respectfully submitted that the application as amended is patentable over the art of record. Reconsideration of the application as amended is respectfully requested.

Claims 1 and 4 have been amended to more clearly describe the subject matter which the Applicant regards as the invention. No new matter has been added.

Claims 1-2, and 7-8 stand rejected under 35 U.S.C. 102(b) as being anticipated by Oba et al. (U.S. Patent No. 5,454,035). Claim 1 has been amended. For the following reasons, the examiner's rejection is respectfully traversed.

Oba does not disclose or teach that "a telephone number stored in the temporary storage memory is registered in at least one telephone directory memory selected from the plurality of telephone directories after making a call" as recited in claim 1. Similar language is found in claims 7 and 8.

Oba discloses registering data of a telephone number by the user selecting the phone-book mode or memo mode and then inputting the telephone number with keys 23 (col. 5, line 59, to col. 6, line 5). In Oba, the telephone number is temporarily stored in an input buffer area 31, before being sequentially registered in the data area 35, 36 (col. 5, line 59, to col. 6, line 5). The telephone number is then later retrieved from the Oba data area to make a call (col. 6, lines 36-38). There is no mention in Oba of registering the telephone number stored in the input buffer area after a call. Therefore, Oba does not teach that a telephone number stored in the temporary storage memory is registered in a telephone directory memory selected from the plurality of telephone directories after a call. Thus, Oba does not disclose or teach all the elements of the claimed invention.

In regards to claim 8, Oba also does not disclose that the telephone directory memory is "selected preliminarily from the plurality of the telephone directory memories so that the telephone number is registered automatically in the preliminarily selected telephone directory after each call". As mentioned previously for claim 1, Oba registers a telephone number by a user selecting a mode and inputting the number (col. 5, line 59, to col. 6, line 5). There is no mention in Oba of preliminarily selecting a telephone directory memory so that the telephone number is automatically registered in the selected telephone directory memory after each call. Thus, Oba does not disclose or teach all the elements of the claimed invention.

Claims 3-6 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Oba et al. in view of Borland (U.S. Patent No. 6,320,943). In a telephone call on 07-29-2003, the Examiner confirmed that the reference Marutiak (U.S. Patent No. 5,568,546) cited in the Office action, dated 07-09-2003, should be Oba et al. (U.S. Patent No. 5,454,035). Claim 4 has been amended. For the following reasons, the examiner's rejection is respectfully traversed.

None of the references disclose or suggest a telephone terminal device with "a buffer directory memory, whose data are erased automatically after passage of a predetermined time" and "in the case the number of the telephone numbers to be registered exceeds the number capable of being stored in the transmitted telephone number record directory memory, the telephone number of the oldest registration order or a telephone number specified by the user is displaced from the transmitted telephone number record directory memory to the buffer directory memory for reregistration" as recited in claim 4. The Office action cites Borland for discloses a transmitted telephone number record memory 103 and a buffer memory within 103 (Office action 07-09-2003, pages 4-5)

Bordland discloses a memory arrangement 103, 203 used to store directory information, such as telephone numbers, identification information, and priority information, of incoming calls, information input by the user, and outgoing calls (col. 4, lines 7-15; and col. 4, line 50, to col. 5, line 27). However, Bordland only discloses one directory. If the Bordland directory is construed as a transmitted telephone

number record directory memory that stores telephone numbers called, then Bordland does not disclose or suggest a buffer directory memory.

In Bordland, the directory may delete telephone numbers based on the priority information provided within the directory in order to free up additional space, such as the least frequently used numbers or numbers that have not been used for a given period of time (col. 7, lines 1-11). The Bordland directory does not disclose or suggest displacing a transmitted telephone number from one directory memory to another directory memory for reregistration. The Bordland directory also does not disclose or suggest displacing a transmitted telephone number based on the oldest registration order or a telephone number specified by the user. Therefore, even if combined, the references do not disclose or suggest all the elements of the claimed invention.

In regards to claims 5 and 6, Borland does not disclose or suggest "an interface means for connection with an external memory device" as recited in claim 5, and "at least one of the telephone directory memories comprises an external memory device connected with a telephone terminal device main body via the interface means" as recited in claim 6. The Office action cites Borland as teaching a single memory or multiple memories, which may also be physically separated (Office action, 07/09/2003, page 5).

Bordland discloses a memory arrangement 103, which may be a single memory or multiple memories that may be physically separated (col. 4, lines 7-15). The Bordland memory arrangement 103 are located within the device. However, Bordland does not disclose or suggest that such memories may be external to the device. Unlike the input device 115 and the display 117, which Bordland indicates may be operatively connected to or built in the device, no mention is made in Bordland that a part of the memory arrangement 103 may be located external to the device (col. 3, line 55, to col. 4, line 27; Fig. 1). Therefore, the physically separated multiple memories in Bordland do not teach or suggest having an interface means for connection with an external memory device or a telephone directory memory that is an external memory device connected with the telephone terminal device main body via the interface means. Thus, even if combined, the references do not disclose or suggest all the elements of the claimed invention.

Furthermore, there is no suggestion or motivation for one skilled in the art at the time the invention was made to combine Oba and Bordland to arrive at the claimed invention. The mere fact that the references can be combined does not render the resultant combination obvious unless the prior art also suggest the desirability of the combination. MPEP §2143.01; *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Oba discloses registering data of a telephone number by the user selecting the phone-book mode or memo mode and then inputting the telephone number with keys 23 (col. 5, line 59, to col. 6, line 5). There is no suggestion or motivation in Oba of having a phone-book mode and memo mode for registering telephone numbers of incoming and outgoing calls. Bordland discloses a memory arrangement 103, 203 used to store directory information, such as telephone numbers, identification information, and priority information, of incoming calls, information input by the user, and outgoing calls (col. 4, lines 7-15, and col. 4, line 50 to col. 5, line 27). There is no suggestion or motivation in Borland of having more than one directory or registering telephone numbers of incoming and outgoing calls in more than one directory. A combination of Oba with Borland would only provide a phone-book mode and a memo mode for registering information input by the user and not for registering telephone numbers of outgoing or incoming calls. Thus, there is no motivation to look at or use the phone-book and memo mode elements in Oba with the memory arrangement in Borland to have multiple telephone directories for incoming or outgoing calls. The desirability of such a modification is found only in the Applicant's own description of the invention, in contrast to the requirement that the teaching or suggestion to make the modification must be found in the prior art, and not based on an applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Reconsideration and withdrawal of the rejection based upon the combination of references is respectfully requested.

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the

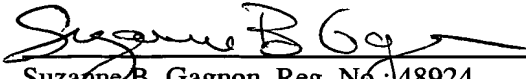
Appl. No. 09/595,204  
Amdt. Dated October 9, 2003  
Reply to Office action of July 9, 2003

application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge the same to our Deposit Account No. 16-0820, our Order No. 32739.

Respectfully submitted,

PEARNE & GORDON LLP

By:   
Suzanne B. Gagnon, Reg. No.: 48924

1801 East 9<sup>th</sup> Street  
Suite 1200  
Cleveland, Ohio 44114-1484  
(216) 579-1700

Date: October 9, 2003